

R E M A R K S

I. Introduction

In response to the pending Office Action, Applicants have cancelled claim 2, without prejudice, and amended claims 1, 4, 9 and 19-26. More specifically, claim 1 was amended to incorporate the limitations set forth in claim 2, which has been cancelled. Claim 9 was also amended to further recite the composition of the conductive filler. Claims 19-26 were amended to address the objection set forth in paragraph 1 of the Office Action. No new matter has been added.

Applicants note with appreciation the indication of allowance of claims 6-8, 18, 20, 22, 24 and 26 and of allowable subject matter being recited by claim 4.

For the reasons set forth below, it is respectfully submitted that all pending claims are patentable over the cited prior art.

It is noted that while claim 1 has been amended, as the amendment merely incorporated the limitations of claim 2, review of amended claim 1 does not present any new issues that would require any additional searching or analysis.

II. The Rejection Of The Claims Under 35 U.S.C. § 103

Claims 1-3, 9, 19, 21, 23, 25 and 27 were rejected under 35 U.S.C. § 103 as being obvious over USP No. 6,262,785 to Ikeda, in view of USP No. 5,822,176 to Sano, and USP No. 5,277,723 to Kodama. For the following reasons, it is respectfully submitted that all pending claims are patentable over the cited prior art.

First, with regard to claim 1, as amended, the claim recites that: (1) a coating is disposed on the external electrode which includes a thermoplastic or thermosetting

resin, and (2) that a conductive adhesive layer is provided on the coating. Referring to Fig. 1, the coating is identified by reference numeral 6 and the conductive adhesive layer is identified by reference numeral 5. As is clearly shown in Fig. 1 and recited by the claim, the coating 6 and conductive adhesive layer 5 of the present invention are distinct and separate layers.

Turning to the cited prior art, as set forth in the pending rejection, Ikeda is relied upon as disclosing both the claimed coating containing a thermoplastic or thermosetting resin disposed on the external electrode and the conductive adhesive disposed on the coating. However, it is clear that Ikeda does not do so. Referring to Fig. 1 of Ikeda, as shown therein, Ikeda discloses an external electrode 5 which is coupled to a wiring electrode 9 via conductive adhesive layer 11. Even assuming *arguendo* that the conductive adhesive layer 11 of Ikeda corresponds to the claimed coating having a thermoplastic or thermosetting resin disposed on the external electrode, Ikeda fails to disclose or suggest an element corresponding to the claimed conductive adhesive layer. Thus, Ikeda fails to disclose or suggest both of the foregoing limitations recited by claim 1. Therefore, as only Ikeda is relied upon as disclosing the two foregoing limitation, and Ikeda fails to do so, the combination of cited prior art fails to establish a *prima facie* case of obviousness. As is well known, in order to establish a *prima facie* case of obviousness, **each and every claim** limitation must be disclosed or suggested by the prior art. See, M.P.E.P. § 2143.03.

It is noted that in the pending rejection, the conductive adhesive layer 11 of Ikeda is asserted as covering both of the foregoing elements recited by claim 1 (i.e., (1) the coating containing a thermoplastic or thermosetting resin disposed on the external

electrode and (2) the conductive adhesive disposed on the coating). Clearly, such an interpretation of Ikeda is also improper. Specifically, as noted above, each and every limitation must be disclosed by the prior art references relied upon to form the rejection. It is improper to rely upon a single element in the reference as disclosing multiple distinct and separate elements in the claims. Thus, in this instance, it is improper to assert that the conductive adhesive layer 11 of Ikeda corresponds to both the claimed coating containing a thermoplastic or thermosetting resin disposed on the external electrode and the conductive adhesive disposed on the coating.

Finally, as noted in Applicants' previous response, the external electrode 5 of Ikeda is a sintered conductive paste, and therefore contains a sintered metal body, but does not contain a resin ingredient. As set forth on col. 3, lines 15-27 of Ikeda, the external electrode 5 is made from a sintered metal body of Ag/Pd and a photocatalyst TiO_2 . The external electrode 5 does not contain any thermoplastic or thermosetting resin. While the conductive paste of Ikeda contains a binder ingredient, the binder evaporates when sintered and does not leave any resin in the final electrode. Thus, there is no resin, much less thermoplastic or thermosetting, that remains in external electrode 5.

Turning to claim 9, this claim recites that the coating of a conductive adhesive disposed on the external electrode contains a conductive filler, and more importantly, that the coating is disposed on the ***entire surface*** of the external electrode (as shown, for example, in Figs. 1 and 2 of the present invention). Turning to the prior art, it is clear that Ikeda does not disclose an external electrode having a conductive coating disposed on the entire surface thereof. Nor does any of the other prior art appear to

cure this deficiency of Ikeda.

Once again, the pending rejection appears to assert that the conductive adhesive layer 11 of Ikeda corresponds to the claimed coating of a conductive adhesive containing a conductive filler formed on the entire surface of the external electrode. However, it is clear that the conductive adhesive layer 11 of Ikeda is disposed only on the lower surface of the external electrode 5 of Ikeda as shown in Fig. 1. Thus, at a minimum, Ikeda does not disclose or suggest the foregoing limitation recited by claim 9.

None of the other prior art references are relied upon as disclosing this limitation. Accordingly, it is respectfully submitted that claim 9 is patentable over the cited prior art.

III. All Dependent Claims Are Allowable Because The Independent Claims From Which They Depend Are Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987).

Accordingly, as claims 1 and 9 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

IV. Request For Notice Of Allowance

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited.

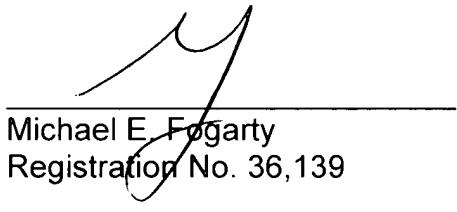
If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

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